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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,795	11/19/2003	George Athanasiou	ATH1P002C1D1	8607

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EXAMINER

COURSON, TANIA C

ART UNIT PAPER NUMBER

2859

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

84-

Office Action Summary

Application No.

10/717,795

Applicant(s)

ATHANASIOU ET AL.

Examiner

Tania C. Courson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 7-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 19NOV03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6 drawn to a fixture, classified in class 33, subclass 552.
 - II. Claims 7-17 drawn to a method of utilizing the tools classified in class 29, subclass 596.
 - III. Claims 18-23 drawn to an indicator tool, classified in class 33, subclass 550.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method claimed in Group II could be performed without employing a fixture as stated in Group I.
3. Inventions in Group I and Group III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention in Group I has separate utility such as providing only a fixture without use of an alignment tool as stated in Group III. See MPEP § 806.05(d).

4. Inventions Group II and Group III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method claimed could be performed without employing an alignment tool as stated in Group III.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Mr. Quin C. Hoellwarth on April 8, 2004, a provisional election was made with traverse to prosecute the invention of Group I (claims 1-6). Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

9. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-2 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Perlotto (US 4,251,922).

Perlotto discloses in Figures 1-3, a gage apparatus comprising:

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- a) a base (Fig. 1, base 10), a reference system (Fig. 1, table 12) and a positioning system (Fig. 1, adjustment mounts, 20, 22 and 24);
- b) wherein said base includes an opening (Fig. 3), and a mounting surface (Fig. 1);
- c) wherein the component is a structural support (Fig. 1, rods 72 and 74) and wherein said positioning system includes a positioning mechanism (Fig. 1, adjustment mounts, 20, 22 and 24), said positioning mechanism including an adjustment screw threadably coupled to said base (Fig. 1, micrometer screw 56);
- d) wherein said positioning system includes a measurement arrangement (Fig. 1, gaging device 14), said measurement arrangement including a measurement post (Fig. 1, rods 72 and 74), said measurement post being structurally coupled to said base (Fig. 1).

With respect to the preamble of the claim 1: the preamble of the claim has not been given any patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self – contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

With respect to claims 1-2 and 5-6: With respect to the intended use of the apparatus, e.g. configured to receive and support said drum assembly, configured to place a portion of said drum assembly in a known position relative to said base, for adjusting the position of said component of said drum assembly relative to said base when said portion of said drum assembly is positioned in said known position, for receiving a portion of said drum assembly therethrough,

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for supporting a portion of said drum assembly thereon, for adjusting the position of said structural support, configured to engage and exert a force on said structural support so as to adjust its position, for checking the alignment of said component of said drum assembly, for receiving a measurement device for measuring the eccentricity of said component: It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Allowable Subject Matter

12. Claims 3-4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reasons for Allowance

13. The following is an examiner's statement of reasons for allowance for dependent claim 3: the prior art does not disclose or suggest an alignment fixture for aligning a component of a drum assembly used in a video recording device including reference pins engaging the outer peripheral surface of said drum assembly in combination with the remaining limitations of the claims.

14. The following is an examiner's statement of reasons for allowance for dependent claim 4:

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the prior art does not disclose or suggest an alignment fixture for aligning a component of a drum assembly used in a video recording device including said component being a drum in combination with the remaining limitations of the claims.

15. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art cited on PTO-892 and not mentioned above disclose gage fixtures:

Monks (US 6,648,708 B2)

Riley, Jr. (US 6,254,077 B1)

Wolf (US 6,247,690 B1)

Fox (US 5,816,568)

Santy (US 3,55,916)

Peterson (US 3,188,078)

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania C. Courson whose telephone number is (571) 272-2239.

The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (571) 272-2245. The fax number for this Organization where this application or proceeding is assigned is (703) 872-9306.



DIEGO F.F. GUTIERREZ
SUPERVISORY PATENT EXAMINER
GROUP ART UNIT 2859

TCC
April 16, 2004